

APPLICATION SERIAL NO. 09/930,482
ATTORNEY DOCKET NO. 53394.000557
RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

II. Remarks

Claims 1-20 are pending in the application. Claim 1-20 are subject to an election/restriction requirement. Applicant hereby adds claims 21-25, which depend from claim 12. Applicant withdraws from consideration claims 7-11 and 16-20 (Groups II-IV and VI). Applicant elects for further prosecution on the merits the system claims, claims 12-15 and newly added claims 21-25 (Group V), and urges that the apparatus claims, claims 1-6 (Group I), should also be included in the elected species, based on the following arguments.

A. Claim Amendments

Claims 21-25 have been added to this application. Claims 21-25 depend from independent claim 12, and should therefore be included in Group V. Support for these amendments may be found, for example, in claims 2-6. No new matter is presented with this amendment.

B. Election/Restriction Requirement - Groups I and V

The Office Action alleges that the inventions of Groups I (claims 1-6) and V (claims 12-15) are related as combination and subcombination, but are otherwise distinct, necessitating a restriction to one of the inventions under 35 U.S.C. § 121. Office Action, pages 3-4. Applicant submits that the restriction requirement between Groups I and V is improper because the combination and subcombination inventions are not distinct. To support a requirement for restriction, it is necessary to demonstrate both two-way distinctness and reasons for insisting on restriction. M.P.E.P. § 806.05(c). In order to satisfy the two-way distinctiveness test it must be demonstrated that: (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. *Id.* Here, the two-way distinctiveness test is not satisfied because the combination claim (e.g., claim 12-15 and 21-25) specifically sets forth the details of the subcombination as separately claimed (e.g., claim 1-6), as required by the first part of the test. Moreover, even if the two-way test were satisfied, there is no valid reason for

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insisting on restriction, because examination of the application does not place a serious burden on the examiner.

The Office Action alleges that in the present application, the first requirement is met because the "the subcombination[s] . . . are not specific in scope so as to be only for exclusive use in the combination claimed in claims 12-15." Office Action, pages 3-4 (emphasis added). However, Applicant is not aware of this "exclusive use" requirement and has been unable to find support for it in the statutes, regulations, or M.P.E.P. Furthermore, Applicant does not believe that the exclusive use requirement is consistent with the first part of the two-way test, because the first part of the test appears to focus on whether the combination claims recite the particulars of the subcombination claims—i.e., whether or not the subcombination claims are for exclusive use in the combination is irrelevant to this inquiry. Here, the combination claims specifically set forth each and every element of the subcombination claims. Therefore, Applicants submit that the two-way distinctness test is not satisfied, and the inventions are not distinct.

Furthermore, even if the inventions are distinct, Applicant submits that an examination for both Groups does not place a serious burden on the examiner. Here, a patentability search for the system claim 12-15 and 21-25 necessarily includes a search for the apparatus claims 1-6, since all of the elements of claims 1-6 are included in the claims 12-15 and 21-25. If the search and examination can be made without serious burden, the examiner must examine the application on the merits, even though it includes claims to independent or distinct inventions. M.P.E.P. § 803.

For at least the foregoing reasons, Applicant respectfully submits that the restriction requirement between the inventions of Groups I and V is improper. As such, Applicant respectfully requests reconsideration and withdrawal of this restriction requirement between Groups I and V, and continued prosecution on the merits of claims 1-6, 12-15 and 21-25.

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III. Conclusion

Applicant believes that no fees are necessary in connection with the filing of this document. In the event any fees are necessary, please charge or credit any such fees, including fees for any extensions of time, to the undersigned's Deposit Account No. 50-0206. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,
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Dated: 10/11/05

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